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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,877	04/04/2001	Takafumi Soramoto	P 280041 VN-0071US	1841
909 7590 03/11/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
GARG, YOGESH C				
ART UNIT		PAPER NUMBER		
3625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/824,877

**Applicant(s)**

SORAMOTO ET AL.

**Examiner**

Yogesh C. Garg

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37, 38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37, 38, 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/30/2008 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed 1/30/2008 is entered. Claims 37 and 38 are amended. Currently claims 37-38 and 40-42 are pending for examination.

### ***Response to Arguments***

3. Applicant's arguments with respect to currently amended claims 37-38 have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37, 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 37 recites inclusion of a human being within its scope (the newly added limitations “.....*the member store paving premium for a deal with the user to the insurance company as a member of the system*”, and “*the user accessing the portal site server for claiming the compensation related to the deal with the member store and then being provided an access to the member store server*” denote manual steps which are performed by a human being (s).

An article or apparatus claim directed to or including within its scope of a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. The applicant's attention is kindly referred to recent ruling by the US Patent and Trade Mark Office, Board of Appeals and Interferences (Ex Parte Bowman, 61 USPQ2d 1669) (Unpublished)) .

Since claims 40-42 are dependencies of claim 37 they would inherit the same deficiency and are therefore rejected for the same reason.

In view of the foregoing, the currently added limitations to claim 37 are to be deleted and this claim and its dependencies would be considered accordingly.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "deal" has been cited several times:

(i) for a deal performed between a member store and a user on the Internet (preamble, Claim 38, line 1).

(ii) the member store to pay premium for the deal (preamble, claim 38, line 3).

(iii) paying premium for a deal with the user to the insurance company (claim 38, line 7).

(iv) the compensation related to the deal with the member store (claim 38, line 12).

(v) storing deal information related to the access to the compensation-granting portal site server (claim 38, line 14).

(vi) granting the compensation related to the deal based on the deal information stored (claim 38, line 16).

From the above recitations in claim 38 it appears that there are two deals, that is the one referred to in i, ii, iii and iv above for which the member store pays the premium to the insurance company and the user claims compensation for it and then there is a second deal referred to in v which relates to the access to the compensating granting portal site server. Thus there being two different deals for which the compensation is to be granted to the user but in vi above the compensation is granted for the deal related to (v) above and it is unclear what happens to the compensation for the deal related to i, ii, iii and iv above. As best understood by the examiner the ii, iii, iv, v, vi above should read as below:

(ii) the member store to pay premium for the deal performed (preamble, claim 38, line 3).

(iii) paying premium for a the deal performed with the user to the insurance company (claim 38, line 7).

(iv) the compensation related to the deal performed with the member store (claim 38, line 12).

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(v) storing deal information related to the ~~access to the compensation-granting portal site server~~  
**the deal performed** (claim 38, line 14).

(vi) granting the compensation related to the **deal performed** based on the deal information stored (claim 38, line 16).

Claim 38 would be considered on merits as understood above by the examiner.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-38 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levison (US Pub: 20020010599A1) in view of McCarty et al. (US Publication 20020029269 A1), hereinafter McCarty.

Note: Claims 37 and 40-42 are directed to an article of manufacturer, that is a computer readable medium and therefore, as analyzed above, the limitations representing human elements, that is “.....*the member store paving premium for a deal with the user to the insurance company as a member of the system*”, and “ *the user accessing the portal site server for claiming the compensation related to the deal with the member store and then being provided an access to the member store server*” would not be considered. Article/Apparatus claims must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a “ recitation with respect to the manner in

which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

With regards to claim 37, Levison discloses or renders obvious a computer readable medium storing thereon a program for causing the computer to perform as a portal site server being a part of a system operated by an insurance company to grant compensation to a user, said system connecting to the portal site server having a first URL to a member store server representing a member store to pay premium for a deal with the user to the insurance company as a member of the system, the system further connecting the portal site server to a user terminal for the user to access to the portal site server for claiming the compensation related to the deal with the member store, the portal site server (see at least Fig.3, paragraphs 0016, 0019, 0030, 0039-0040. Levison teaches that an insurance company via computer implemented system allows users/consumers using Internet browsers to access its web site via Internet and then provides insurance coverage as an incentive for transactions initiated at its website. As stated in paragraphs 0016, 0019, 0030, 0039-0040 the insurance coverage is provided as a reward/incentive to the user for carrying out a targeted transaction, which can include buying a member merchant's [store's] products. In paragraph 0040 Levison explicitly teaches that the disclosed invention can be further modified and as taught in McCarty Levison's system can be modified to access seamlessly a particular

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merchant's [store's] web site via the insurance company's web site itself (see at least McCarty, Abstract, Fig.2, paragraphs 0048-0062. Information system 108 represents a web site, through which a user 102 can access seamlessly other external web pages/websites through external system. The structure disclosed in fig.2 reads on the structure claimed by the applicant that is 108 representing the insurance company web site, 102 representing an user and 104 is s external system to access web pages such as that of a member store and all these entities interconnected via a network 106 and where both 108 and 104 have URLs, that is 108 is having the first URL and 104 having the second URL to access them, see paragraph 0062. McCarty (see at least paragraphs 0052, 0056—0059) teaches an information system 108 having a first URL, similar to the one as recited in claim 37 for an insurance company system, comprising of a portal web site in the form of an integrator module 120 communicating with user modules 120 via communication network and then by using rewriting units enabling the users to access member merchant's web pages, having second URL, via external system for purchasing or for any other purpose like accessing library information, etc. ) comprising:

a compensation-granting database configured to store URL information of the member store in advance, the member store paying premium for a deal with the user to the insurance company as a member of the system (see Mc Carty at least, Fig.3, paragraphs 0113-0116. Database 134 stores the access information for users and the access information includes the relevant URL for the web pages being requested by



users. The intended step of a member store paying premium for a deal, such as providing insurance for a product being purchased is implied );

a URL rewriting unit which receives a second URL of a web page of the member store server upon a user's request, rewrites said second URL to be linked to said first URL if the second URL requested by the user is found in said URL information-stored in the compensation-granting database, and transmits said rewritten to the user terminal~ the user accessing the portal site server for claiming the compensation related to the deal with the member store and then being provided an access to the member store server (see McCarty at least Fig.5, paragraphs 0094-0096, 0103, 0123-0125);

a history database for storing deal information including information related to the access to the portal site server by the user (see Mc Carty at least, Fig.3, paragraphs 0113-0116. Database 134 stores the access information for users and this stored information includes information related to the access to the portal site server by the user, such as time or period when the user was last using services or products, see at least paragraphs 0059 and 0069 ); and

a compensation-granting unit for granting the compensation to the user based on the deal information stored in the history database (see at least Levison, paragraphs 0016, 0030, 0039).

It would be obvious to one of an ordinary skilled in the art to modify Levison's computer implemented method/system (see paragraphs 0030 and 0039) being adapted by an insurance company, in view of McCarty, to utilize URL rewriting to establish a session, authenticate the user and grant the user the right to access the merchant's

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web site or any other web page to conduct business of buying products and maintain the authenticated session while the user is logged in to the merchant's web page, as demonstrated in McCarty (see paragraphs 0094-0096).

Regarding claim 38, its limitations are closely parallel to the limitations of claim 37 and is therefore analyzed and rejected based on the same rationale as set forth for claim 37.

Regarding claim 40, Levison in view of McCarty teaches that the user pays additional premium to the insurance company (see at least Levison, paragraphs 0006, 0019, 0024 which teach that the reward is a partial credit towards the insurance coverage and the rest is paid by the user himself.).

Regarding claim 41, Levison in view of McCarty teaches that the deal information further includes a validity of the compensation to be granted (see at least Levison, paragraphs 0039).

Regarding claim 42, Levison in view of McCarty teaches that the deal information further including information related to a time of final access to the portal server by the user (see at least McCarty, paragraph 0071 teaching storing information about the user including last login or the like.).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Douvikas et al. (US 20050182644 A1, see at least paragraph 0148) and Reisman (US Patent 6769009, see at least col.42, lines 25-34) teach URL rewriting units as a well-known prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/29/2008